

## **REMARKS**

### **I. INTRODUCTION**

In response to the non-final Office Action, no amendments to the claims are made herewith. All of the outstanding claim rejections are traversed for the reasons set out below.

### **II. THE CLAIM REJECTIONS UNDER 35 U.S.C. § 103 SHOULD BE WITHDRAWN**

The March 4, 2009 Office Action contained multiple claim rejections under 35 U.S.C. 103, namely:

- a rejection of claims 1-3, 8-10, 15-17, and 22-24 as being unpatentable for obviousness over U.S. Patent Application Publication No. 2001/0054181 to Corvin (hereinafter, “Corvin”) in view of U.S. Patent Application Publication No. 2007/0067800 to Wachtfogel (hereinafter, “Wachtfogel”), in further view of U.S. Patent Application Publication No. 2002/0144262 to Plotnick et al. (hereinafter, “Plotnick”); and
- a rejection of claims 4-16, 11-13, 18-20, and 25-27 as being unpatentable for obviousness over Corvin in view of Wachtfogel and Plotnick, further in view of U.S. Patent No. 6,993,727 to De Ceulaer (hereinafter, “De Ceulaer”).

Such rejections are traversed.

#### **A. The Rejections of Claim 1 and The Claims Depending Therefrom Should be Withdrawn**

With respect to independent claim 1, the March 4, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... “in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a

notification<sup>1</sup>.” In seeking to remedy this deficiency in Corvin’s disclosure, the Office Action alleges that Wachtfogel discloses the foregoing feature. The examiner’s characterization of Wachtfogel’s disclosure relating to specific elements of claim 1 is provided below, together with Applicant’s comments regarding same.

<u>Claim Element</u>	<u>Portion of Wachtfogel Alleged by Examiner to Correspond to Claim Element</u>	<u>Applicant’s Comments</u>
“in response to a first control signal”	<p>[0173] “[The commercial set of parameters may preferably define the following additional information and/or tags which specifically characterize the commercial:] ... expiration after a predetermined number of people have seen the commercial.”</p> <p>[0181] “Preferably, the parameter disabling the option of “fast-forward/fast-backward” when the commercial is displayed may be employed to prevent situations in which the user watches a movie and skips the commercial, the commercial being preferably associated with the movie. When this parameter is employed, the processor 45 prevents browsing, and the user may either view the commercial or pass to another program.”</p>	<p>¶ [0173] refers to a parameter that defines information and/or tags characterizing a commercial. According to ¶¶ [0169]-[170], such parameters are assigned by the broadcaster to a commercial as attributes that that prevent skipping a commercial without viewing it.</p> <p>¶ [0173] refers to disabling “fast-forward/fast-backward” but does <u>NOT</u> teach or suggest disabling of switching <u>from a first channel to a second channel</u> as required by claim 1.</p>
“allowing the switching in response to a second control signal”	<p>[0182] Preferably, the parameter disabling the option of “<b>fast-forward/fast-backward</b>” when the commercial is displayed may be employed only until the user has seen the commercial a predetermined number of times in a predetermined time period, such as a week, or a predetermined number of commercials in the predetermined time period. ...</p> <p>[0183] It is appreciated that the parameter disabling the option of <b>fast-forward/fast backward</b> is not employed in a mode in which the user only browses through available programs.</p> <p>[0184] Alternatively, the operations of <b>fast-</b></p>	<p>¶¶ [0182]-[0184] repeatedly refer to disabling “fast-forward/fast-backward” but do <u>NOT</u> teach or suggest disabling of switching <u>from a first channel to a second channel</u> as required by claim 1.</p> <p>Note that “browsing” is discussed by Wachtfogel, for example, at ¶¶ [0026] (“fast-forward/fast backward browsing”), [0034] (“retrieving the program in accordance with a browsing hierarchy”); [0039] (“apparatus also preferably includes a NEXT key selector associated with the processor and the memory and operative to browse through television programs stored in the memory”), [0159] (“The key 125 on the remote control 110 may preferably be employed by the user as a</p>

<sup>1</sup> See March 4, 2009 Office Action, page 3.

<u>Claim Element</u>	<u>Portion of Wachtfogel Alleged by Examiner to Correspond to Claim Element</u>	<u>Applicant's Comments</u>
	<p><b>forward and fast-backward</b> are enabled and the user may be required to pay more money if he does not watch a predetermined number of commercials per a predetermined time period, such as a month.</p>	<p>"NEXT" button to browse forward through programs stored in any of the memories 55 and 65"), [0161] ("When the user browses through the first hierarchy of stories by pressing one of the plurality of "NEXT" buttons, the user may pass, for example, from a first story in a news program to a second story in the news program"); [0162] ("When the user browses through the second hierarchy of sections by pressing another one of the plurality of "NEXT" buttons, the user may pass, for example, from a news section related to politics in the program to a news section related to sports in the program.") <b>All of the foregoing mentions by Wachtfogel of "browsing" are consistent with sequential review of programs (e.g., subject to fast-forward/fast-backward), not with switching between channels.</b></p>
<p>"the second control signal being provided at the end of the video program"</p>	<p>[0170] Preferably, the additional attributes are assigned to the commercial by the broadcaster by associating a commercial set of parameters to the commercial in addition to the above mentioned broadcaster set of parameters.</p> <p>[0181] Preferably, the parameter disabling the option of "fast-forward/fast-backward" when the commercial is displayed may be employed to prevent situations in which the user watches a movie and skips the commercial, the <b>commercial being preferably associated with the movie</b>. When this parameter is employed, the processor 45 prevents browsing, and the user may either view the commercial or pass to another program.</p> <p>[0182] Preferably, the parameter disabling the option of "fast-forward/fast-backward" when the commercial is displayed may be employed only until the user has seen the commercial a predetermined number of times in a predetermined time period, such as a week, or a predetermined number of commercials in the predetermined time period. It is appreciated that the predetermined number of</p>	<p>¶ [0181] refers to a "commercial being preferably associated with the movie," without disclosing any control signal provided at the end of the video program.</p> <p>As mentioned previously, ¶ [0173] refers to a parameter that defines information and/or tags characterizing a commercial. According to ¶¶ [0169]-[170], such parameters are assigned by the broadcaster to a commercial as attributes that that prevent skipping a commercial without viewing it. <b>Such attributes are associated with a commercial irrespective of timing of such commercial relative to a video program.</b></p> <p>Wachtfogel therefore fails to clearly specifically any control signal that is provided at the end of the video program.</p> <p>But even if Wachtfogel disclosed a control signal provided at the end of a video program, ¶ [0181] of Wachtfogel refers to <b>prevention</b> of "fast-forward/fast-backward" browsing – <b>rather than allowing</b> switching between channels in response to the second control</p>

<u>Claim Element</u>	<u>Portion of Wachtfogel Alleged by Examiner to Correspond to Claim Element</u>	<u>Applicant's Comments</u>
	times that a user must see a commercial may vary from user to user. Similarly, the predetermined number of commercials that a user must see may vary from user to user.	signal provided at the end of a video program.

As detailed in the foregoing table, Wachtfogel fails to disclose disabling of switching from a first channel to a second channel, or *allowing* such switching (i.e., rather than *preventing* fast-forward/fast-backward browsing) in response to a second control signal provided at the end of a video program. For at least these reasons, Wachtfogel fails to support the obviousness rejection of claim 1, such that this rejection should be withdrawn.

Plotnick relates to a system for presenting a viewer with an alternative brief version of an advertisement (a so-called “trick play” advertisement, such as a static screen presenting a logo or portion of the commercial, a condensed version of the actual advertisement, or an alternate or entirely unrelated advertisement) when the viewer chooses to fast-forward through a commercial<sup>2</sup>. In one embodiment, the viewer sees the fast-forwarded commercial in one portion of the screen while the alternative brief version is displayed<sup>3</sup>.

The examiner alleges that Plotnick, at paragraph [0229] thereof, “teaches ‘wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification (*i.e.*, start of advertising notifies user and user is prevented from switching if the ad progresses too far)’<sup>4</sup>.” Such characterization of Plotnick as disclosing prevention of channel switching does not square with the description in paragraph [0229] of prevention of fast forwarding, as indicated below.

[0229] According to one embodiment of the invention, the PVR determines the location with the advertisement when the trick play event (i.e., fast forward) is initiated, and if applicable the speed of the trick play

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<sup>2</sup> See Plotnick, ¶ [0059].

<sup>3</sup> Id.

<sup>4</sup> See March 4, 2009 Office Action, page 4.

event. If a determination is made that the ad has progressed too far, or that the speed is too great, or some combination thereof, the PVR may either prevent the trick-play event or skip the alternative ad. In another embodiment, the alternative ad will be initiated and the trick play event will be paused for the time it takes to complete the alternative advertisement

Additionally, the foregoing passage of Plotnick fails to disclose any "notification" that defines a starting point of a time period after which a viewer is prevented from switching channels, as required by claim 1. For at least these reasons, Plotnick fails to support the obviousness rejection of claim 1, such that this rejection should be withdrawn.

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 1 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend<sup>5</sup>, the claims depending (whether directly or indirectly) from claim 1 are likewise distinguished over the cited art.

*B. The Rejections of Claim 8 and The Claims Depending Therefrom Should be Withdrawn*

In the March 4, 2009 Office Action, the rejection of independent claim 8 is premised on the same portions of Corvin, Wachtfogel, and Plotnick as cited in connection with claim 1. The arguments raised hereinabove with respect to claim 1 are hereby incorporated by reference with respect to claim 8.

The March 4, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... "in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification<sup>6</sup>."

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<sup>5</sup> 35 U.S.C. 112, fourth paragraph.

<sup>6</sup> See March 4, 2009 Office Action, page 4.

It has been previously established herein that Wachtfogel fails to disclose disabling of switching from a first channel to a second channel, or *allowing* such switching (i.e., rather than *preventing* fast-forward/fast-backward browsing) in response to a second control signal provided at the end of a video program, as required by independent claim 8.

It has also been previously established herein that Plotnick fails to disclose preventing of channel switching, or any "notification" that defines a starting point of a time period after which a viewer is prevented from switching channels, as required by independent claim 8.

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 8 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend<sup>7</sup>, the claims depending (whether directly or indirectly) from claim 8 are likewise distinguished over the cited art.

C. The Rejections of Claim 15 and The Claims Depending Therefrom Should be Withdrawn

In the March 4, 2009 Office Action, the rejection of independent claim 15 is premised on the same portions of Corvin, Wachtfogel, and Plotnick as cited in connection with claim 1. The arguments raised hereinabove with respect to claim 1 are hereby incorporated by reference with respect to claim 15.

The March 4, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... "in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification<sup>8</sup>."

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<sup>7</sup> 35 U.S.C. 112, fourth paragraph.

<sup>8</sup> See March 4, 2009 Office Action, page 6.

It has been previously established herein that Wachtfogel fails to disclose disabling of switching from a first channel to a second channel, or *allowing* such switching (i.e., rather than *preventing* fast-forward/fast-backward browsing) in response to a second control signal provided at the end of a video program, as required by independent claim 15.

It has also been previously established herein that Plotnick fails to disclose preventing of channel switching, or any "notification" that defines a starting point of a time period after which a viewer is prevented from switching channels, as required by independent claim 15.

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 15 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend<sup>9</sup>, the claims depending (whether directly or indirectly) from claim 15 are likewise distinguished over the cited art.

*D. The Rejections of Claim 22 and The Claims Depending Therefrom Should be Withdrawn*

In the March 4, 2009 Office Action, the rejection of independent claim 22 is premised on the same portions of Corvin, Wachtfogel, and Plotnick as cited in connection with claim 1. The arguments raised hereinabove with respect to claim 1 are hereby incorporated by reference with respect to claim 22.

The March 4, 2009 Office Action concedes that Corvin fails to disclose prevention of user channel switching ... "in response to a first control signal and allowing the switching in response to a second control signal, the second control signal being provided at an end of the video program, wherein the viewer is prevented from the switching after expiration of a selected period of time after a notification"<sup>10</sup>.

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<sup>9</sup> 35 U.S.C. 112, fourth paragraph.

<sup>10</sup> See March 4, 2009 Office Action, pages 7-8.

It has been previously established herein that Wachtfogel fails to disclose disabling of switching from a first channel to a second channel, or *allowing* such switching (i.e., rather than *preventing* fast-forward/fast-backward browsing) in response to a second control signal provided at the end of a video program, as required by independent claim 22.

It has also been previously established herein that Plotnick fails to disclose preventing of channel switching, or any "notification" that defines a starting point of a time period after which a viewer is prevented from switching channels, as required by independent claim 22.

Based on the foregoing failure of Wachtfogel and Plotnick to disclose elements conceded by the examiner to be absent from Corvin, withdrawal of the rejection of independent claim 22 is warranted, and is respectfully requested. Because dependent claims inherently include all of the features of the claims on which they depend<sup>11</sup>, the claims depending (whether directly or indirectly) from claim 22 are likewise distinguished over the cited art.

E. The Rejections of Dependent Claims 4-6, 11-13, 18-20, and 25-27 Should be Withdrawn

In the March 4, 2009 Office Action, claims 4-16, 11-13, 18-20, and 25-27 were rejected under 35 U.S.C. 103 as being unpatentable for obviousness over Corvin in view of Wachtfogel and Plotnick, further in view of De Ceulaer.

Each of claims 4-16, 11-13, 18-20, and 25-27 depends, whether directly or indirectly, from one of independent claims 1, 8, 15, or 22. The patentable distinctions of independent claims 1, 8, 15, and 22 over Corvin, Wachtfogel, and Plotnick have been discussed hereinabove. De Ceulaer fails to remedy the above-identified deficiencies of Corvin, Wachtfogel, and Plotnick in disclosing all elements of independent claims 1, 8, 15, and 22. Because dependent claims inherently include all of the features of the claims on which they depend, dependent claims 4-16, 11-13, 18-20, and 25-27 are patentably

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<sup>11</sup> 35 U.S.C. 112, fourth paragraph.



distinguished over the cited art for at least the same reasons as presented hereinabove with respect to independent claims 1, 8, 15, and 22. Accordingly, withdrawal of the rejections of dependent claims 4-16, 11-13, 18-20, and 25-27 is warranted, and is respectfully requested.

*F. The Rejections of Dependent Claims 7, 14, 21, and 28 Should be Withdrawn*

In the March 4, 2009 Office Action, claims 7, 14, 21, and 28 were rejected under 35 U.S.C. 103 as being unpatentable for obviousness over Corvin in view of Wachtfogel, Plotnick, and De Ceulaer, further in view of U.S. Patent No. 5,943,605 to Koepele (“Koepele”).

Each of claims 7, 14, 21, and 28 depends, whether directly or indirectly, from one of independent claims 1, 8, 15, or 22. The patentable distinctions of independent claims 1, 8, 15, and 22 over Corvin, Wachtfogel, and Plotnick have been discussed hereinabove. De Ceulaer and Koepele fail to remedy the above-identified deficiencies of Corvin, Wachtfogel, and Plotnick in disclosing all elements of independent claims 1, 8, 15, and 22. Because dependent claims inherently include all of the features of the claims on which they depend, dependent claims 7, 14, 21, and 28 are patentably distinguished over the cited art for at least the same reasons as presented hereinabove with respect to independent claims 1, 8, 15, and 22.

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**CONCLUSION**

In light of the foregoing, Applicants respectfully submit that all of the now-pending claims are in condition for allowance. Examination of all pending claims and issuance of a notice of allowance are earnestly solicited. Should any issues remain that may be amenable to telephonic resolution, the examiner is invited to telephone the undersigned attorneys to resolve such issues as expeditiously as possible.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 14-1270.

Respectfully submitted,

**By:**    /vincent k. gustafson/  
          Vincent K. Gustafson  
          Registration No.: 46,182

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INTELLECTUAL PROPERTY/  
TECHNOLOGY LAW  
P.O. Box 14329  
Research Triangle Park, NC 27709  
Phone: 919-419-9350

**For:**    Kevin C. Ecker  
          Registration No.: 43,600  
          Phone: (914) 333-9618

**Please direct all correspondence to:**  
Kevin C. Ecker, Esq.  
Philips Intellectual Property & Standards  
P.O. Box 3001  
Briarcliff Manor, NY 10510-8